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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,129	01/16/2004	Peter S. Brown	ENDOV-63893	7202
24201	7590	06/12/2006	EXAMINER	
FULWIDER PATTON 6060 CENTER DRIVE 10TH FLOOR LOS ANGELES, CA 90045			MILLER, CHERYL L	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/760,129

Applicant(s)

BROWN ET AL.

Examiner

Cheryl Miller

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-27 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6 and 9-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 7, 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input checked="" type="checkbox"/> Other: <u>Attachments 1-3</u>        |

### DETAILED ACTION

The previous rejection has been withdrawn, in light of a new interpretation of the Wolinsky patent (US 6,840,956 B1). The current rejection is non-final.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the sensor" in line 3. There is insufficient antecedent basis for this limitation in the claim. A sensor has only been cited in the preamble as intended use language, therefore, has not yet been positively claimed. It is suggested to change "the sensor" to recite --a sensor--.

Claim 1 also recites the limitations "a graft" and "the graft" in lines 5 and 7 respectively. There is insufficient antecedent basis for these limitations in the claim. Only an "unfolded graft" has been previously recited. It is unclear if "a graft" and "the graft" are the same as the "unfolded graft" or in addition to.

Claims 2, 4, 7, and 8 depend upon claim 1 and inherit all problems associated with the claim.

Referring to claim 2, a *possible new matter* situation exists. The claim requires that the graft material be configured into a H-shape *along with* covering the sensor (as in the independent claim 1). In the applicant's figures, it seems that the H-shape only exists in figure 8, *prior to*

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“folding graft material to cover the sensor”. In figures 9 and 10, wherein the graft material is folded over the sensor, the H-shape, *appears to no longer exist*. Therefore, since claim 1 requires that the graft material be folded to cover the sensor, it is unclear how the H-shape can also be coexisting as claimed in 2.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Reich et al. (US 2002/0183628 A1). Reich discloses a method of protecting a sensor attached to a graft comprising configuring a membrane of a sensor (s1, s2, s3) so that the membrane is substantially perpendicular to a radius of an unfolded graft (seen clearly in fig.3, 4; attachment 1), attaching a sensor (s1, s2, s3) to the unfolded graft (inner layer 20), folding a graft material (patch) to cover the sensor (placing a patch over the first unfolded graft may be considered to be “folding graft material over the sensor”; since the “graft material” is not required by the claim to be part of the unfolded graft, it may be considered a separate piece, such as a patch, which may be folded down onto the over the unfolded graft; see P0029) and placing the graft within a catheter (40).

Reich discloses a single folded section (patch) of graft material covering the sensor (s1, s2, s3).

Claims 1, 2, 4, 7, 8 rejected under 35 U.S.C. 102(e) as being anticipated by Wolinsky et al. (US 6,840,956 B1, cited previously. Wolinsky discloses a method of protecting a sensor attached to a graft (col.5, lines 38-45) comprising; configuring a membrane of a sensor (12) so that the membrane is substantially perpendicular to a radius of an unfolded graft (see attachment 2), attaching a sensor (12) to the unfolded graft (14), folding a graft material to cover the sensor (see either fig.3A or 3B) and placing the graft (14) within a catheter (32).

Wolinsky discloses a single or multi folded section of graft material covering the sensor (figs.3A, 3B). Wolinsky discloses configuring the graft to an H-shape (fig.3A may be considered an H-shape as it is similar to the configuration shown by applicant's own figures; see attachment 3).

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheryl Miller



**BRUCE SNOW**  
PRIMARY EXAMINER

## US 2002/0183628 A1

**FIG. 4**

radius axis

Pc

S8

22

20

Pa

14

S3

S3

10

sensor (S3) axis

Sensor axis  $\perp$  radius axis

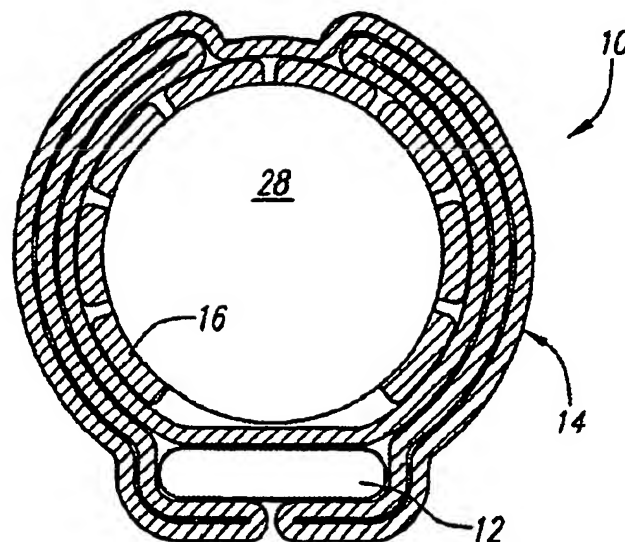
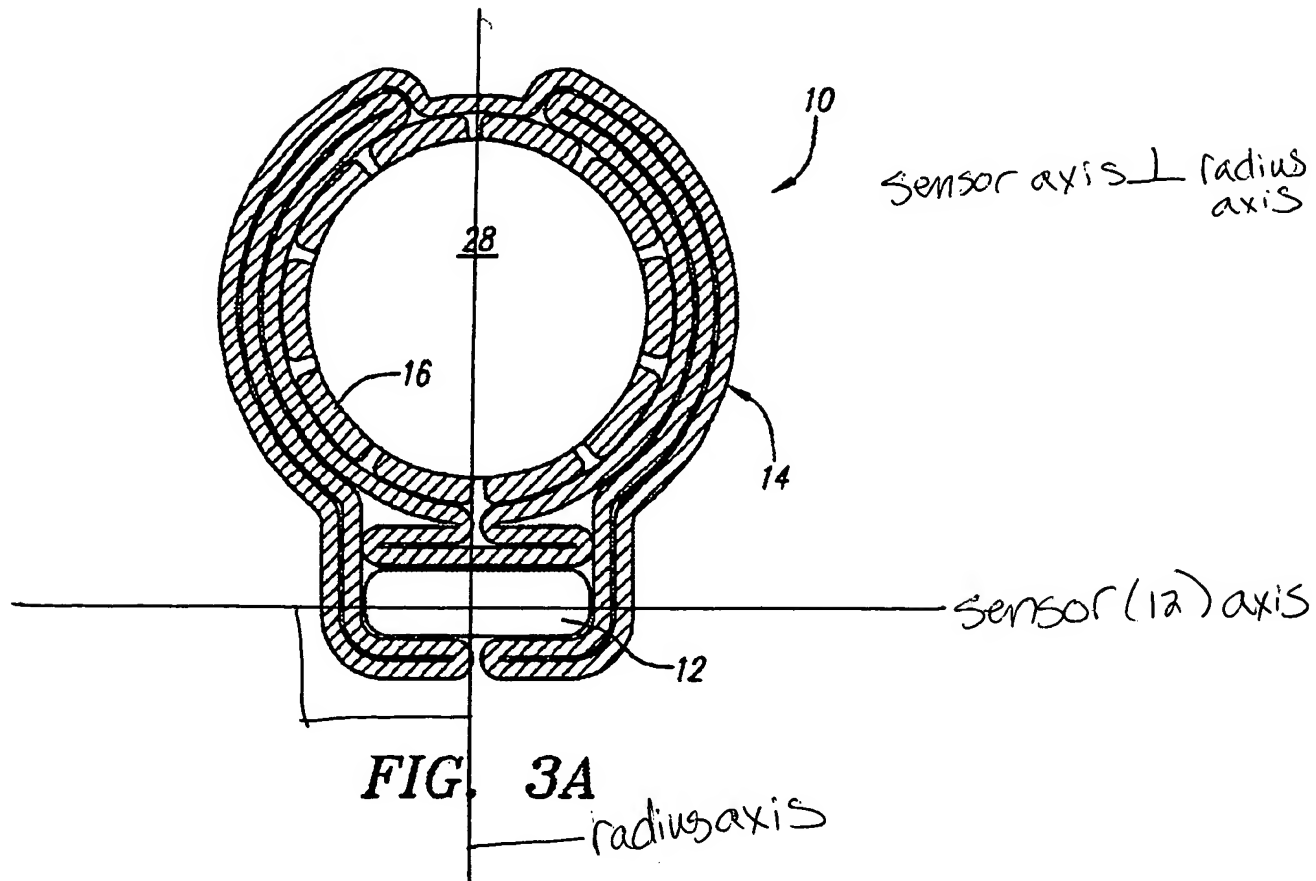
# Attachment #2 (marked up)

U.S. Patent

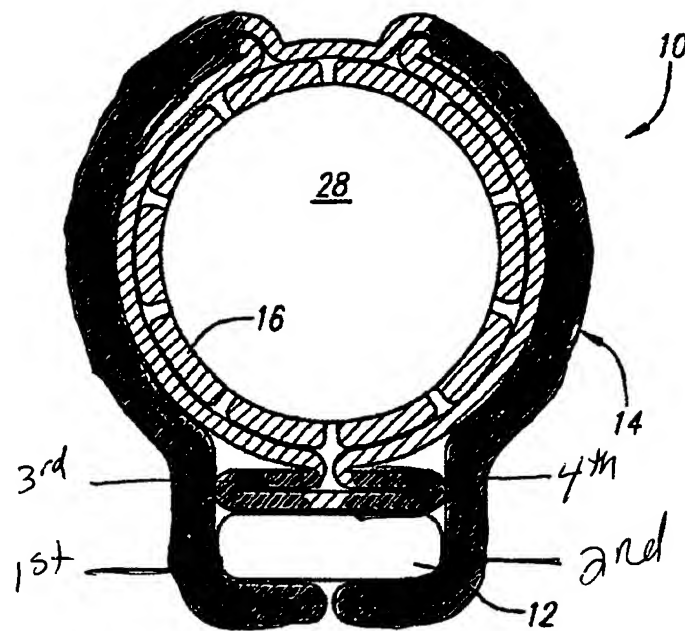
Jan. 11, 2005

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★ 4 legs of  
"H" seen  
shaded in red  
separately

FIG. 3A

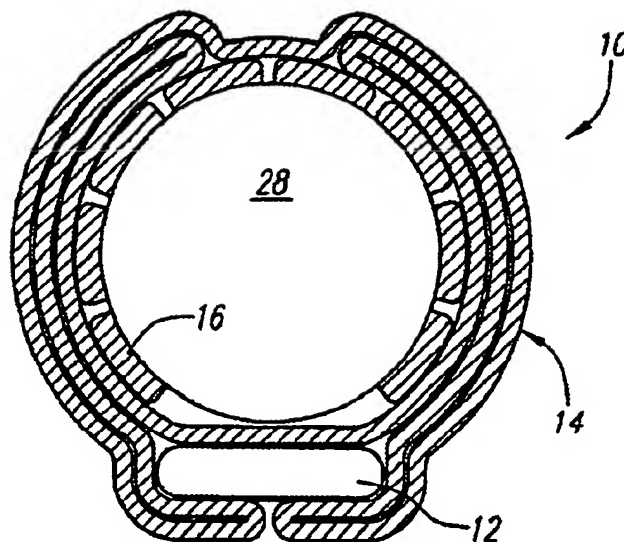


FIG. 3B